

### **AMENDMENT TO THE DRAWINGS**

Fig(s). 2A and 2B have been amended. The attached sheet of formal drawings replaces the original sheet including Figs. 2A and 2B.

### **REMARKS/ARGUMENTS**

Claims 10-17, 20-21 and 24-31 are pending in the instant application. Favorable reconsideration is kindly requested.

### **Amendments to the Application**

Independent claims 10, 16 and 24 are amended to include the feature that the treatment section loop is symmetric with respect to the loop central axis, and further that the proximal end of the loop comprises first and second curved proximal ends connecting the loop to the elastic deformable portion, the first and second curved proximal ends being asymmetric with respect to the loop central axis. These features are fully supported throughout the specification as originally filed, for example at Fig. 2A, and the accompanying description beginning p. 8, line 11 through p. 9, line 4. No new matter has been added.

Claim 24 is amended to also recite the proximal end of the loop comprises first and second curved proximal ends connecting the loop to the elastic deformable portion, the first and second curved proximal ends being asymmetric with respect to the loop central axis.

Consistent with discussion in a prior telephone interview, the specification and drawings are amended to explicitly recite and show a tilting axis, which was merely implied by original description of a lateral tilting. The specifications and drawings also include an arrow in the direction of the originally described lateral tilting. No new matter has been added. The Examiner also requested explicit reference to the claimed loop plane, which is already shown at 10d of Fig. 2B.

### **Rejections Under 35 U.S.C. § 102**

Claims 10-12, 14-17, 20-21, 24-27 and 29-30 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,256,113 to Chamness ("Chamness"). Applicant respectfully traverses the rejection.

Without prejudice to the pending rejections, Applicant respectfully submits that the claims are patentably distinguished in view of the amendments described above. Independent claims 10, 16 and 24 each recite

An endoscopic treatment apparatus comprising:

...

a treatment section ... being laterally extendable for forming a loop when the treatment section is extended from [an] opening of [a] sheath by movement of [an] actuating member, ... the loop being symmetric with respect to [a] loop central axis, ... the proximal end of the loop comprising first and second curved proximal ends connecting the loop to the elastic deformable portion, the first and second curved proximal ends being asymmetric with respect to the loop central axis...

Independent method claim 24, as amended above, also recites first and second curved proximal ends connecting the loop to the elastic deformable portion, the first and second curved proximal ends being asymmetric with respect to the loop central axis. The curved proximal ends being asymmetric with respect to the loop central axis assures that the loop bends in a lateral direction.

The amended claims are patentably distinguished over Chamness. In contrast to the claimed features, Figs. 1 and 3 of Chamness illustrate that there is no corresponding curved proximal ends which are asymmetric with respect to the loop central axis. According to Chamness, all portions of the loop (36) are symmetrical with respect to the loop central axis, e.g. Chamness Figs. 3-4. Accordingly, the loop of Chamness does not bend in a lateral direction, but rather bends in a vertical direction, e.g., Chamness Fig. 1.

It is well settled by the courts that “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984). Therefore, because the structure and effect of Chamness is materially different than the present claims, Applicant respectfully submits that claims 10, 16, 24 and 25 are patentable over Chamness.

Claims 11-15 and 20 each depend, either directly or indirectly, from independent claim 10. Claims 17 and 21 each depend from independent claim 16. Claims 26-30 each depend, either directly or indirectly, from independent claim 25. These dependent claims are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claims, whose features are incorporated by reference. Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Claims 10-12, 14-17, 20-21, 24-27 and 29-30 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,840,176 to Ohno (“Ohno”). Applicant respectfully traverses the rejection.

With reference to the above-cited features of independent claims 10, 16, 24 and 25, Ohno does not teach these features of the claims. In a first embodiment (Fig. 3), Ohno teaches that a treating element (24) is a solid element (Fig. 5), and when extended the treating element is curved to one side of sheath (4). The plane which includes the treating element, i.e., one which includes a line connecting the distal and proximal ends of the treating element, is not substantially parallel to a moving axis of the actuating member. Turning then to a second embodiment, generally Fig. 6., Ohno discloses that in this second embodiment, “snare wire 40 serves as a treating element.” Col. 4, lines 41-42. There is no teaching that the snare wire (40) takes on a different orientation from the flat treating element (24). Therefore, the perspective-sectional view of Fig. 6 must be interpreted consistent with its description, which is that the snare loop is merely a substitute for the spade, and is oriented similarly, i.e. the loop plane is not substantially parallel with the moving axis of the actuating member. In other terms, the snare wire (40) of Fig. 6 takes the place of the perimeter of the treatment section (24) in Figs. 3, 5. It is a misinterpretation of Ohno to assert that the perspective view of the snare loop (40) meets the claimed features of the independent claims that the loop plane is substantially parallel with a moving axis of the actuating wire. The text of Ohno does not support that interpretation.

Viewed in the proper light then, Ohno does not meet the features of the present claims. Because, as shown above, the loop of Ohno does not bend in a lateral direction relative to the moving axis of the actuating member, the loop does not include first and second curved proximal ends connecting the loop to the elastic deformable portion, with the first and second curved proximal ends being asymmetric with respect to the loop central axis. Like Chamness above, the loop of Ohno and the curved proximal portions are symmetric, because the loop deflects vertically, not laterally.

Therefore, independent claims 10, 16, 24 and 25 will be seen as patentable over Ohno. Dependent claims 11-15, 17, 20-21 and 26-30 are each separately patentable, but are offered as patentable for at least the same reasons as their underlying independent base claims, whose features are incorporated by reference. Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

### **Rejections Under 35 U.S.C. § 103**

Claims 13 and 28 were rejected under 35 U.S.C. § 103(a) as obvious over either Chamness or Ohno taken singly. Applicant respectfully traverses the rejection.

In both rejections, the Office Action asserts that bending the end of the treatment apparatus is a mere design choice/shape change. "In a proper obviousness determination, whether the changes from the prior art are minor, the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's device. This includes what could be characterized as simple changes..." *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) (internal quotes and citation omitted). Accordingly, *Chu* held that the PTO erred in finding that the difference between the claimed invention and the prior art was merely a matter of "design choice."

In this case, there is no assertion of any apparent reason to modify either Chamness or Ohno to arrive at the claimed invention, even presuming that such a modification would have been a "design choice" as the Office Action asserts. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

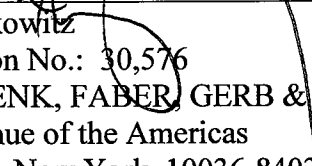
Moreover, as illustrated above, neither Chamness nor Ohno, either singly or in combination, teach or suggest all features of the underlying independent base claims. Therefore, Applicant respectfully submits that the rejection is poorly taken, and kindly requests favorable reconsideration and withdrawal.

**Conclusion**

In light of the foregoing, Applicant respectfully submits that all claims are patentable, and kindly requests an early and favorable Notice of Allowability.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
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Respectfully submitted,



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